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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/571,650	12/13/95	YASUDA H	7217/48794

LM02/0415

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EXAMINER	
FERGUSON,K	
ART UNIT	**PAPER NUMBER**
2746	15

DATE MAILED: 04/15/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/571,650	Yasuda et al.
Examiner	**Group Art Unit**
Keith Ferguson	2746

☒ Responsive to communication(s) filed on *Feb 22, 1999* .

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-19* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-19* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 U.S.C. § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-5, 11-15,18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlberg et al. in view of Yoshizawa.

Regarding claims 1,2 and 18, Ahlberg et al. discloses a communication terminal for informing a user of a receive call from a remote caller by an alert sound (col. 6 lines 35-39), comprising an alert sound generator (col. 6 lines 35-39), a control means (control means) (fig. 2 number 45), a keypad is depressed (determining whether a predetermined operation is operated when an alert sound is rung (fig. 2 numbers 50,62, and 48 and column 6 lines 49-69 and column 10 lines 1-8), whereby an operation state of the alert sound generator is generating the alert sound (col. 6 lines 42-45), and means for specifying the predetermined operation is operated by the user (col. 6 lines 45-48). Ahlberg et al. differs from claim 1 of the present invention in that it does not explicit disclose means for specifying the predetermined operation is operated by an user, the control means controls the alert sound generator to change a volume of the alert sound only for the receive call, without affecting the volume of the alert sound for future receive calls, while a call ringing state, as perceived by the remote caller, of the terminal from the remote caller remains unchanged. Yoshizawa discloses a sound generator is generating an alert sound and a switch (19) (means specifying the predetermined operation operated) by an user (fig. 1 and col. 2 lines 32-46) controller (14) (control means controls) the alert sound generator to change a volume of the alert sound only for the receive call (fig. 1 and col. 2 lines 39-44), without affecting the volume of the alert sound for future receive calls (col. 2 lines 43-44), while a call ringing state, as perceived by the remote caller, of the terminal from the remote caller remains unchanged (col. 2 lines 32-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Ahlberg et al. with means for specifying the predetermined

operation is operated by an user, the control means controls the alert sound generator to change a volume of the alert sound only for the receive call, without affecting the volume of the alert sound for future receive calls, while a call ringing state, as perceived by the remote caller, of the terminal from the remote caller remains unchanged in order to change calling formats by the user according to the user's situation or environment, as taught by Yoshizawa.

Regarding claims 3 and 19, Yoshizawa discloses the control means controls the state of said alert sound generator to reduce the volume of the alert sound (col. 2 lines 32-46).

Regarding claim 4,5 and 15, the combination of Ahlberg et al. and Yoshizawa differs from claims 4,5 and 15 of the present invention in that they do not explicit disclose a power key. However, power keys are well known in the art such as in telephones keypads in order to operate a telephone by pressing an on/off switch. When a caller is trying to call a cellular telephone the operator of the cellular telephone would depress a power key which places the call off hook canceling a ringing signal. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a power key in order to turn a telephone on or off.

Regarding claim 11, Ahlberg et al. discloses a display (fig. 2 number 68).

Regarding claim 12, Ahlberg et al. discloses a transceiver (RF signal processing means) and an antenna (fig. 2 number 32 and 74).

Regarding claim 13, Ahlberg et al. discloses waiting to receive a call (column 10 lines 20-25), ring an alert sound upon receiving a call (column 10 lines 20-25), and changing the state of the alert sound when a predetermined operation is operated (column 10 lines 25-29).

Regarding claim 14, the combination of Ahlberg et al. and Yoshizawa differs from claim 14 of the present invention in that they not disclose depressing a predetermined key for a time shorter than a predetermined period of time. However, Ahlberg et al. discloses activating the hold selecting means (depressing a key for a predetermined mount of time) (column 6 lines 48-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to depress a predetermined key for a time shorter than a predetermined period of time in order to place the caller on hold.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlberg et al. in view of Yoshizawa as applied to claim 14 and 13 above and in further view of Higuchi et al.

The combination of Ahlberg et al. and Yoshizawa differs from claim 16 of the present invention in that they do not disclose a predetermined period of time is substantially equal to one second. Higuchi et al. discloses an user may answer a call by pressing a send key (predetermined period of time is substantially equal to one second)(column 8 lines 69 and column 9 line 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the combination of Ahlberg et al. and Yoshizawa with a predetermined period of time is substantially equal to one second in order to answer a incoming call which discontinue a telephones ringing, as suggested by Higuchi et al.

5. Claims 6-10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlberg et al. in view of Yoshizawa as applied to claims 1 and 13 above and in further view of Roeder and Knuth et al.

Regarding claims 6-10, the combination of Ahlberg et al. and Yoshizawa differs from claims 6-10 of the present invention in that they not disclose a power source, wherein the control means breaks off power when the power key is depressed for at least a predetermined period of time and the control means changes the state of the alert generator when said power key is depressed shorter than the predetermined period of time. However, telephones comprising a control means, multifunction keys and a power source is well known in the art such as a power key used to power on/off a telephone by pressing a key (substantially equal to one second) which eliminates a ringing signal of an incoming call. Roeder discloses a dual mode keypad permitting one touch dialing (a key is depressed shorter than the predetermined period of time)(title and abstract). Knuth et al. teaches an one touch control telephone answering device that can perform multiple functions all by activating a single button (changes the state of the alert generator)(column 1 lines 28-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the combination of Ahlberg et al. and Yoshizawa with a power source, wherein the control means breaks off power when the power key is depressed for at least a predetermined period of time and the control means changes the state of the alert generator when said power key is depressed shorter than the predetermined period of time in order to provide one touch activation such as turning off a telephone ringing signal by pressing a single key without eliminating the regular function of a standard keypad, as suggested by Roeder and Knuth et al.

Regarding claims 17, The combination of Ahlberg et al. and Yoshizawa differs from claim 17 of the present invention in that they do not disclose a step of changing the state of the alert sound includes the step of toggling the predetermined operation. However, the teaching of toggling a telephone key in a telephone keypad is well known in the art such as a dual mode keypad permitting one touch dialing as taught in Roeder (U.S. Patent 5,491,745)(title and abstract). Knuth et al. (U. S. Patent 5,406,618) teaches an one touch control telephone answering device that can perform multiple functions all by activating a single button (column 1 lines 28-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the combination of Ahlberg et al. and Yoshizawa with a step of changing the state of the alert sound includes the step of toggling the predetermined operation to provide multifunction operation of a single key as taught by Roeder and Knuth et al.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 308-5403, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Keith Ferguson whose telephone number is (703)305-4888.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

Keith Ferguson, Examiner KF

Art Unit 2746

April 7, 1999

WELLINGTON CHIN
SUPERVISORY PATENT EXAMINER
GROUP 2700